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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,616	11/02/2001	Joseph C. Salamone	P02360	5258

7590

06/03/2003

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EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,616

Applicant(s)

SALAMONE ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/9/03 Response.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1,6 and 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5,7-9 and 15-24 is/are rejected.
- 7) ☒ Claim(s) 2-5, 7-9 and 15-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: English translation of JP 07-098441 and JP 07-097410.

DETAILED ACTION

1. The Applicants' response to restriction requirement filed on May 9, 2003 was received.
2. Applicant's election of the invention of Group II (Claims 2-5, 7-9 and 15-24) in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Groups I, III, IV and V (Claims 1, 6, 10-14) are withdrawn for further consideration.

3. In the PTO-1449 form filed on March 12, 2003, the two references in the OTHER DOCUMENTS section should refer to JP 0-07410 and JP 07-09841. Accordingly, the information of these two Japanese patent numbers has been added into the corresponding references.

Claim Objections

4. Claims 2-5, 7-9 and 15-24 are objected to because of the following informalities:
Should the limitation of Claim 1 be included in Claims 2-5, 15-18 and 20-23?
Furthermore, in line 6 of Claim 1, should "alkyl", "alkyloxy", "aryl" and "aryloxy" be -- alkylene --, -- alkyleneoxy --, -- arylene -- and -- aryleneoxy --, respectively?

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7-9 attempt to claim a process without set forth any steps involved in the process, thus causing indefiniteness. Ex Parte Erlich, 3 USPQ 2d 1011 (BPAI 1986).

In Claim 8 (line 3), methyl methacrylate is typically considered as a hydrophobic monomer.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 2-3, 5, 20-21 and 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakakibara441 (JP 07-098441).

Sakakibara441 discloses a polymeric composition produced through the polymerization of triphenylvinylsilane, a monomer of formula I and a third monomer ([0008] and[0014]). The third monomer can be an aromatic or non-aromatic non-siloxy based monomer such as

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phenylacrylate (a hydrophobic monomer), 1,3,5-triacryloylhexahydro-s-triazine (a crosslinking agent), divinylbenzene (a crosslinking agent), etc. ([0014]).

9. Claims 2-3, 5, 20-21 and 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakakibara410 (JP 07-097410).

Sakakibara410 discloses a polymeric composition produced through the polymerization of triphenylvinylsilane or diphenyldivinylsilane, diallyisophthalate and a third monomer ([0008] and [0014]). The third monomer can be an aromatic or non-aromatic non-siloxy based monomer such as phenylacrylate (a hydrophobic monomer), divinylbenzene (a crosslinking agent), etc. ([0014]).

10. Claims 2-5, 7-9 and 15-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (US 4 594 401).

Takahashi discloses a polymeric composition produced through the polymerization of trimethylsilylstyrene and an aromatic or non-aromatic non-siloxy-based monomer of hydrophilic monomers such as dimethylacrylamide, etc. and/or hydrophobic monomers such as methyl methacrylate, 2-ethylhexyl methacrylate, cyclohexyl methacrylate, cyclohexyl acrylate, etc. (col, 2, line 66-68, col. 3, lines 56-62, col. 4, line 26 to col. 5, line 51). Note that the hydrophobic monomers can be used alone or in admixture thereof (col. 4, lines 26-42). A crosslinking agent such as ethylene glycol dimethacrylate, ethylene glycol diacrylate, trimethylolpropane triacrylate, etc. can be used. (col. 3, line 63 to col. 4, line 11).

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11. Claims 2-3, 5, 7, 15-16, 18-21 and 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchida (US 4 742 136).

Uchida discloses a polymeric composition produced through the polymerization of an aromatic-based monomer of formula (5) and one or more comonomers such as methyl methacrylate (a hydrophobic monomer), ethylene glycol dimethacrylate (a crosslinking agent), cyclohexyl methacrylate (a hydrophobic strengthening agent), phenyl acrylate (a hydrophobic monomer), triallyl cyanurate (a crosslinking agent), etc. (col. 2, line 50 to col. 3, line 44 and col. 5, lines 36-49).

12. The "X" references cited in the international search report are not relied upon because of the following reason:

None of US 2 958 681 and US 5 142 009 teaches or fairly suggests a polymeric composition comprising an aromatic-based silyl monomer.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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Kuo-Liang Peng

May 28, 2003

A handwritten signature in black ink, appearing to read "Kuo-Liang Peng", written in a cursive style.